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10/774,302	02/06/2004	Lawrence J. Terzo	36194-95262	5443
7590 Alice O. Martin Barnes & Thornburg P.O. Box 2786 Chicago, IL 60690-2786		08/08/2007	EXAMINER WOOD, ELIZABETH D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/774,302
Filing Date: February 06, 2004
Appellant(s): TERZO, LAWRENCE J.

John P. Wappel
For Appellant

EXAMINER'S ANSWER

MAILED
AUG 08 2007
GROUP 1700

This is in response to the appeal brief filed May 4, 2007 appealing from the Office action mailed January 26, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0127026

Anderson et al.

7-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, 7-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite in the recitation of "a concrete mixture effective at an ambient temperature of..." as it is unclear what this statement means. What does

effective mean? Concrete mixture can be considered "effective" as long as it cures.

This terminology adds nothing to the claims under consideration.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 4 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2003/0127026 to Anderson et al.

The instant claims involve an additive for cement comprising a non-chloride accelerator and a nitrate compound. The claims also recite a method for accelerating set time by adding this additive to concrete.

Anderson et al. disclose at page 7 that examples of accelerators for use in their concrete include non-chloride type accelerator and/or calcium nitrate. This disclosure is

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considered to adequately describe applicants claimed additive and the method for adding such to concrete. Page 9 discusses other additives such as fly ash.

The only difference between the instant claims and the reference disclosure is apparently the intended use language "for use in concrete at temperatures of..." and "accelerating the set time". The instantly claimed invention would have been obvious because "for use" is simply a statement of intended use and does not confer patentability on the claimed admixture. Regarding "accelerating the set time", it is considered that such would be an inherent characteristic of the Anderson et al. cement composition because it contains the same substances being claimed herein by applicants. The mixture of the two substance will ultimately result in the claimed characteristics.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

(10) Response to Argument

Appellant's arguments filed in the brief have been fully considered but they are not persuasive.

With respect to the rejection under the second paragraph of 35 USC 112, the appellant argues that "effective" clearly means curing at low temperatures. This position is not convincing to the examiner. The claim recites in step a the preparation of a concrete mixture "effective" as asserted by appellant of curing at low temperatures. This clearly is not correct however, because the cement does not yet have the additive

therein, so it is not effective to carry out the function asserted by appellant. Accordingly, the language presented remains imprecise and confusing.

With respect to the obviousness-type rejection, appellant's arguments assert that the examiner's position that it would have been obvious to select known additives for known functions has "no legal authority" in support thereof. This line of reasoning has not been found convincing because in the first place, the very fact that a substance is called an "accelerator" or a "water reducer" in and of itself recognizes that many additives in the cement art have specific and known functions assigned to them by those familiar with the technology. Moreover, Anderson et al. specifically suggest the addition of particularly suitable additives such as a "nitrite based corrosion inhibitor" and a "nonchloride type accelerator". Clearly the addition of these substances for their known and disclosed function has been explored and addressed by both the prior art and the examiner in a thorough manner absent any "legal authority". However, simply to satisfy appellant that such legal authority actually exists, appellant is directed to *In re Leshin*, 125, USPQ 416, *Lyon v. Bausch & Lomb*, 106 USPQ 1 and *Graver Tank* 85 USPQ 328.

With respect to the further argument that both a suggestion to make a composition and a reasonable expectation of success must be found in the prior art, this position has been addressed by the examiner in the hereinabove statement of the rejection. The examiner pointed out that the same two substances employed by appellant are defined as accelerators by Anderson, which clearly indicates to the skilled artisan a reasonable expectation that curing will be accelerated by the addition of either or both of the compounds. Appellant's statements that Anderson does not teach the

nitrite in combination with other additives has other properties is not relevant at this point in the prosecution because the burden of a prima facie case of obviousness has already been met. Moreover, simply because Appellant may have recognized a new characteristic associated with the addition of known substances, such does not rise to the level of a patentable invention unless the claims are strictly commensurate with this new and unexpected characteristic. As discussed and suggested by the examiner in the office action mailed January 26, 2006:

"The examiner suggests claiming the specific compounds in the specific amounts required by and demonstrated in the specification to provide unexpected results. Alternatively, the applicant could provide data demonstrating that different accelerators and inhibitors in different amounts also provide the benefits achieved with the two specific compounds already exemplified. The examiner notes that such showing would have to be quite extensive however, because the terms "non-chloride type accelerator" and "nitrite-based corrosion inhibitor" are so broad and embrace so many substances. A significant number of examples would have to be presented to establish a trend that the "unexpected" results achieved by applicant would actually be expected across the broad range of possible combinations that fall within the generic claims."

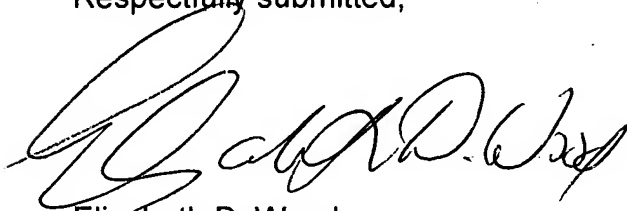
In other words, the examiner completely considered evidence of unexpected results in the specification and did not consider them sufficient and commensurate in scope with claims of the breadth of those under examination in the instant application.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Elizabeth D. Wood

Conferees:

Jerry Lorengo

Chris Fiorilla



J.A. LORENZO
SUPERVISORY PATENT EXAMINER

